



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/932,784	09/18/97	MCKAIN	J A0521/7125

LM01/0816

PETER J GORDON
WOLF GREENFIELD & SACKS
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON MA 02210

EXAMINER

NGUYEN, H

ART UNIT	PAPER NUMBER
----------	--------------

2715

19

DATE MAILED: 08/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/932,784

Applicant(s)
MCKAIN et al

Examiner
HUY NGUYEN

Group Art Unit
2715



☒ Responsive to communication(s) filed on May 19, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1, 2, and 4-44 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, and 4-44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2715

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-2 and 4- 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al (5,946,445) in view of Bohrman (5,109,482).

Regarding claims 1-2, 9 and 23, Peters discloses a digital motion picture recorder comprising:

a housing sized to be portable for use by an individual (Fig. 1);

Art Unit: 2715

processing means (Fig. 1) in the housing for processing the motion video signal;
a converting means for converting the motion video signal into a sequence of the still image (column 2);
storage means (5) for storing the sequence of still images on a computer readable and rewritable random access medium mounted in the housing (column 3).

Peters at fig 1 fails to specifically teach that the motion camera mounted in the housing having the recorder. However, it is noted that combine two separate parts to become an integral part or making a portable part is obvious in view of a practitioner in the art (See integral or separate part , In re Larson et al.). . Therefore, it would have been obvious to one of ordinary skill in the art to modify the digital recorder of Peters by providing a motion camera in the same housing of the digital recorder for portability 's purpose therefore providing more advantages on use on location or studio. Furthermore, it is noted that Peters and applicant also suggest the motion camera and the digital recorder can be organized to be portability (See Peter column 3, lines 43-50, in the specification of the instant application page 4) and it is well recognized that a camera which integral with a digital recorder to make portable is well recognized in the art.

Peters fails to teach the use of an editing unit for editing by defining a sequence of the digital to be played back.

Bohrman teaches an editing unit which is used with a computer for editing the prestored video information, defining a sequence of the still video information to be reproduced .

Art Unit: 2715

It would have been obvious to one of ordinary skill in the art to modify Peters with Bohrman by using an editing device as taught by Bohrman in the apparatus of Peters for editing the video information stored on the medium in order to provide convenience to the user in editing the digital still picture.

Regarding claims 4, 10, 24, Peters as modified with Bohrman further teaches a display and editing control to edit and display the sequence of the still picture (See Peters column 3, lines 30-40 and Bohrman (Fig. 2, column 1, lines 15-25 column 2, lines 15-25)

Regarding claims 5,6,12, 13, 15, 26, 27, 40, Peter as modified with Bohrman teaches that the medium is a random access medium and a disk type is detachable .

Regarding claim 7, Peters fails to specifically teach that the portable housing is ruggedized. However, it is noted that ruggedizing a device is well known in the art and also it is required by customer. Therefore, it is would have been obvious to one of ordinary skill in the art to make the housing of the recorder of Peters is ruggedized in order to provide the digital recorder with more endurance.

Regarding claims 11, 25, 38, Peter as modified with Bohrman fails to teach display functions associated with an input mechanism. However, it is noted that using display function and an input mechanism associated with display function to enabling a user to select an associated function is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify Peters as modified with Bohrman to provide display functions

Art Unit: 2715

and associated input mechanism in order to provide more convenience to the user in operation the digital recorder.

Regarding claims 14,28 and 39, Peters fails to the housing comprise a shell and a shock absorbing cushions between the shell and disk type drive. However, it is noted using a shock absorbing cushions to prevent vibration and firmly hold a part is well known in the art. Therefore Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Peters by incorporating a shell and a shock absorbing cushions between the shell and disk drive to prevent the vibration of the disk.

Regarding claims 16, 17,30, 31 and 42, Peters fails to specifically teach the use of a data address bus to provide the digital still image to a computer interface. However, it is noted that using a data address bus to provide data to a computer network is well known in the art. Therefore it would have been obvious to one of ordinary skill in the art to modify Peter by providing data address bus to provide still digital images to a computer interface to transmitting the still digital to a designated destination.

Regarding claims 8, 18 and 32, Peters fails to teach the calibration of the color of the still digital picture However, it is noted that using means for calibration color of the picture is well known in the art. Therefore, Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Peters by using a means for calibrating the color of the digital still picture in order to improve the quality of the digital still picture.

Art Unit: 2715

Regarding claim 19,33 and 43, Peters fails to specifically teach the means for overlaying information indication of time code or date on the digital still picture signal. However, it is noted that overlay date or time code or information on a picture is well known in the art. Therefore the Official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Peters by using means for generating time code or date and overlaying the date or time code on the digital still picture in order to accurately identify the still picture.

Regarding claims 20,21,34,35 and 44, Peter fails to teach the use of encoder for the digital still picture. However, it is noted that using an encoder for encoding video signal comprising digital still pictures is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify Peters by using an encoder for the digital still picture for encoding the digital still picture.

Regarding claims 22, 36 and 37, Peters further teaches that the digital still picture is conforming with NTSC format.

Response to Arguments

3. Applicant's arguments filed May 19, 2000 have been fully considered but they are not persuasive.

In Remarks, pages 2 and 3, applicants argue that "a portable video system as taught in Peter would still receive a signal from an external device . . . rather than Applicants a putting

Art Unit: 2715

together a video system including an editor with a camera which is not even part of Peters". In response, it is submitted that when the camera and the digital recorder as disclosed by Peters are put together to form a portable video system, the signal would be received by the video system. Further, it is noted that putting a camera and a digital recorder to form a portable video system is well recognized in the art. Furthermore, it is noted that using an editor together with a recording/ reproducing apparatus is well known in the art as taught by Bohrman, Bohrman teaches an editor which is used with a recording/reproducing apparatus to edit the video signals. Therefore, it would have been obvious to one of ordinary skill in the art to using an editor as taught by Bohrman with the digital recorder as taught by Peters to edit the motion picture which comprises a sequence of the still images disclosed by Peters. Since using an editor in associated with a digital recording/reproducing apparatus would provide more convenience to the user in editing the images and this is a motivation that would lead a practitioner in the art to use an editor with the video system of Peters. Since the claimed video system is merely formed by the well-known parts putting together, the combination of a camera, a digital recorder as taught by Peters and the editor as taught by Bohrman would produce the claimed video system.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2715

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Nguyen whose telephone number is (703) 305-4775. The examiner can normally be reached on Monday to Friday from 6:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber, can be reached on (703) 305-4929.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Serial Number: 08/932,784

Page 9

Art Unit: 2715

Washington, D.C. 20231


or faxed to:

(703) 308-6306

Or:

(703) 308-6296

Hand-delivered responses should be brought to **Crystal Park II, 2121 Crystal Drive,**
Arlington. VA., Sixth Floor (Receptionist).


HOY NGUYEN
PRIMARY EXAMINER

H.N

August 13, 2000